

REMARKS

The applicant notes that Claims 40 to 59 are rejected under 35 U.S.C. § 112 as being indefinite. Claims 40 to 42, 45, 52, 53 and 55 to 59 are rejected under 35 U.S.C. 102(b) as being anticipated by the disclosure of Oland in U.S. Patent No. 5,704,474, and that Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosure of Oland in U.S. Patent No. 5,704,474.

To overcome the Examiner's rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a), and in particular, in order to distinguish the invention from the prior art, Claim 40 has been deleted, and a new Claims 60-62 have been added. Claim 60 now claims the storage case for a data or music disc as comprising inter alia:

an inner carrier, which is now claimed as defining a front end and a rear end, as well as defining a disc accommodating means between the front end and the rear end for receiving and storing a disc therein with the disc defining a storing plane. Additionally, the inner carrier is claimed as being slideable in the outer shell in a front end/rear end direction between a closed position within the outer shell and an open position extending outwardly of the outer shell for providing access to the disc accommodating means,

a guide means in the inner carrier for slideably guiding the disc in a sideward direction in the storing plane between the front and rear ends into and out of the disc accommodating means when the inner carrier is in the open position, and

a securing means in the inner carrier for securing the disc in the disc accommodating means against sliding movement in the storing plane through the guide means.

It is respectfully submitted that it is precisely the provision of the three features (a) to (c) of the storage case according to the invention that provides the storage case with the many advantages over prior art storage cases. These advantages are discussed in the specification from page 7, line 19 to page 8, line 9.

It is respectfully submitted that none of the prior art discloses a storage case for a data or music disc which comprises the above three features (a), (b) and (c). Furthermore, it is respectfully submitted that Oland in U.S. Patent Specification No. 5,704,474 also fails to disclose a storage case for a data or music disc with the above three features. Additionally, it is respectfully submitted that not only does the prior art fail to disclose a storage case for a data or music disc which comprises the above three features (a), (b) and (c), but none of the prior art specifications, including the disclosure of Oland in U.S. Patent Specification No. 5,704,474, suggest the provision of a storage case for a data or music disc which includes the above three features (a), (b) and (c), whether the prior art documents are considered separately or combined.

Oland in U.S. Patent Specification No. 5,704,474 discloses a storage case for a compact disc, which may be an audio compact disc or a data carrier compact disc, which comprises an outer shell 1 and an inner carrier 2. The inner carrier 2 is slideable in a front end/rear end direction between a closed position within the outer shell and an open position extending outwardly of the outer shell, and the inner carrier also defines a disc accommodating means. A securing means, namely, brackets 29 and 36 retain a compact disc in the disc accommodating means of Oland. However, in Oland to insert a disc in the disc accommodating means, the disc must be lowered into the disc accommodating means between the brackets 29 and 36. In other words, to place a disc in the disc accommodating means of Oland, one must urge the disc in a

direction perpendicular to the storing plane of the disc when the disc is located in the disc accommodating means of Oland. Additionally, to remove a disc from the disc accommodating means of Oland the disc must be raised upwardly from the disc accommodating means, in other words, also in a direction perpendicular to the storing plane of the disc.

As discussed above, new Claim 60 requires that the guide means of the present invention is provided for slideably guiding the disc in a sideward direction in the storing plane between the front and rear ends into and out of the disc accommodating means when the inner carrier is in the open position. It is respectfully submitted that Oland in U.S. Patent Specification No. 5,704,474 fails to disclose such a guide means being provided for slideably guiding the disc in a sideward direction in the storing plane. In Oland, as mentioned above, the disc is placed in the disc accommodating means by lowering the disc into the disc accommodating means, in other words, in a direction perpendicular to the storing plane of the disc, and is removed by raising the disc from the disc accommodating means also in a direction perpendicular to the storing plane. Thus, even if the brackets 29 and 36 of Oland were considered to be guide means, these brackets do not act to slideably guide the disc in a sideward direction in the storing plane of the disc.

Accordingly, it is respectfully submitted that Oland fails to disclose the invention of the new Claim 60. Furthermore, it is respectfully submitted that there is no suggestion in the disclosure of Oland of the provision of a guide means, even if the brackets 29 and 36 were to be considered as a guide means for guiding a disc into and out of the disc accommodating means of Oland, such a guide means would not or could not act to slideably guide a disc in a sideward direction in the storing plane between the front and rear ends into and out of the disc accommodating means.

Additionally, it is respectfully submitted that none of the other prior art documents disclose a storage case for a data or music disc which includes the feature of such a guide means in an inner carrier for slideably guiding a disc in a sideward direction in the storing plane of the disc between the front and rear ends of the inner carrier into and out of a disc accommodating means when the inner carrier is in the open position. Furthermore, there is no suggestion in any of the other prior art documents of the provision of such a guide means. It is therefore respectfully submitted that the invention of the new Claim 60 is novel, and furthermore is not obvious in the light of the disclosure of Oland, whether Oland is considered separately or combined with any one or more of the other prior art documents.

It is respectfully submitted that there is a fair basis in the specification for the revisions which have been made to new Claim 60. At page 11, line 20 to line 24 the inner carrier 5 is referred to as being formed in two parts having “a main carrier 13 and an outer tray 14”. The main carrier 13 is described as comprising “a support plate 15 from which a pair of spaced apart parallel front and rear end walls 16 and 17, respectively, extend upwardly”. Thus, it is submitted that there is clearly a fair basis for the inner carrier defining a front end and a rear end. At page 11 from line 2 to line 5 it is stated that “the storage case 1 comprises an outer shell 4 of plastics material within which an inner carrier 5 also of plastics material for storing a compact disc 2 is slideable between a closed position illustrated in Fig. 2 within the outer shell 4, and an open position illustrated in Fig. 1 extending outwardly from the outer shell 4 ...”. From this, it is respectfully submitted that it is evident that the inner carrier 5 is slideable in front end/rear end directions between the closed position within the outer shell and the open position extending outwardly from the outer shell.

At page 12, lines 14 to 16, it is clearly stated that “a guide means for guiding a compact disc 2 in the (storing) plane 18 from either side 23 or 24 of the inner carrier 5 into the disc storing area 20 is provided on each side of the retaining member 19, and each guide means comprises a forward guide plate 25 extending from the front end wall 16 and a pair of rearward guide plates 26 extending from the rear end wall 17”. At page 12, lines 18 to 21 it is clearly stated that “the guide plates 25 and 26 (guide means) co-operate with the corresponding support benching 21 for guiding the compact disc with the compact disc 2 lying in the storing plane 18 into and out of the disc storing area 20 from either side 23 or 24 thereof.” Thus, it is respectfully submitted that this paragraph on its own clearly provides a fair basis for the guide means for feature (b) above in the revised Claim 60. Clearly, if the disc is to be slideably guided by the guide means into the disc accommodating area while the disc is in the storing plane between the front and rear ends, the disc must be slideable in a sideward direction, thereby, it is respectfully submitted a fair basis is provided in the specification for feature (b).

At page 15 from line 20 to line 24 it is stated that “when it is desired to withdraw a compact disc 2 from one of the storage cases 1 the inner carrier 5 is slid from the closed into the open position, and the compact disc is slid sidewardly to one or other side 23 or 24 against the resilient action of the corresponding disc engaging clip 30 outwardly from the disc storing area 20.” Further, it is stated at page 15, lines 24 and 25 that “the compact disc 2 is slid from the disc storing area 20 between the guide plates 25 and 26 and the support benching 21 in the storing plane 18.” Since withdrawal of a compact disc from the storing area 20 is the reverse of insertion, it is respectfully submitted that this passage in the specification also clearly provides a fair basis for feature (b) above of Claim 60.

In preparing new Claim 60, the misspelling of the word “closed” as “dosed” which occurred in Claim 40 has been corrected. The misspelling of the word “closed” as “dosed” has also been corrected in Claims 44, 46 and 58. Additionally, Claims 45, 54 and 57 have been revised to remove the words “preferably” and/or “advantageously” in order to ensure that these claims are no longer indeterminate. Additionally, similar revisions have been made to Claims 46, 48, 53, 54 and 59 to similarly remove the words “preferably” and/or “advantageously”.

Regarding the objection raised in paragraph 6 to Claim 56 based on the lack of an antecedent basis for “the lower support means”, the dependency of Claim 55 has been revised so that Claim 55 is now dependent on Claim 43, which provides an antecedent for “the lower support means” claimed in Claim 56, since Claim 56 is dependent on Claim 55.

Regarding the objection raised in paragraph 6 to Claim 59 based on an alleged lack of an antecedent basis for “a second grip means”, it is respectfully submitted that since the “second grip means” has been introduced in Claim 59 with the indefinite article, an antecedent is not required.

Turning now to paragraph 4 of the official letter, where the Examiner has indicated that Claims 40 to 59 include sundry “means” which are allegedly unclear, it is respectfully submitted that the use of the term “means” throughout Claims 40 to 59 is eminently clear. Indeed, it is respectfully submitted that in describing the preferred embodiment of the invention, which is described in the specification with reference to Figs. 1 to 22 of the drawings, the implementation of the various “means” of the invention is clearly described. However, the applicant wishes to emphasise that the description of the implementation of the various “means” in the preferred embodiment of the invention is not intended to be in any way limiting of such “means”.

The following comments are given with reference to the description of the preferred embodiment of the invention which is described in the specification from page 8 to page 16 to assist the Examiner in understanding the claims. The disc accommodating means is formed in the inner carrier 5 of the preferred embodiment of the invention by a compact disc storing area 20. The inner carrier 5 including the disc accommodating means is clearly described in the specification from page 11, line 20 to page 12, line 12. The securing means for securing the compact disc in the disc storing area against sideward slideable movement is provided by a pair of resilient disc engaging clips 30 which are integrally formed with the rear end wall 17. The securing means is clearly described in the specification from page 12, line 25 to page 13, line 12.

The guide means for guiding the compact disc 2 in the storing plane 18 from either side 23 or 24 of the inner carrier 5 into the disc storing area 20 is provided on each side of the retaining member 19 and comprises a forward guide plate 25 extending from the front end wall 16 and a pair of rearward guide plates 26 extending from the rear end wall 17. A full and clear description of the guide means appears in the specification at page 12 from line 14 to line 23.

The lower support means which is claimed in Claim 43 is described in the specification at page 11 from line 22 to line 23, although at page 11, line 22 the lower support means is referred to as "a support means".

The upper retaining means, which is also claimed in Claim 43, is described in the specification from page 11, line 24 to page 12, line 5.

The locating means which are claimed in Claims 52 and 53, including the first and second male and female locating means, are clearly described in the specification at page 14, line 14 to page 15, line 14.

The term “label receiving means” in Claims 55 and 56 has been revised to “label accommodating means”, and the term “label accommodating means” is clearly described in the specification from page 13, line 14 to line 21.

The first and second grip means, which are claimed in Claims 58 and 59, are clearly described in the specification from page 14, line 1 to line 8.

It is respectfully submitted that the above explanation as to the “means” claimed in the claims should be sufficient to allow the Examiner to understand the claims. However, the applicant again emphasises that the preferred embodiment which is described in the specification with reference to the drawings from page 8 to page 16 is a non-limiting example of the invention, and it is intended that the features which are identified as “means” be interpreted to include other suitable means as well as those described in the preferred embodiment of the invention.

In view of the above, it is respectfully submitted that the new Claim 60 complies with the requirements of U.S. Patent law, and now clearly and unambiguously defines the scope of the invention. Additionally, as discussed above, it is respectfully submitted that the invention of new Claim 60 is novel and not obvious. Accordingly, it is respectfully submitted that new Claim 60 should be allowable and allowance is respectfully requested.

Since the remaining Claims 41 to 59 and 61 and 62 are dependent either directly or indirectly on the new Claim 60, it is respectfully submitted that once the Examiner is satisfied of the allowability of the new Claim 60, the remaining Claims 41 to 59 and the new Claims 61 and 62 should likewise be allowable, and allowance is respectfully requested.

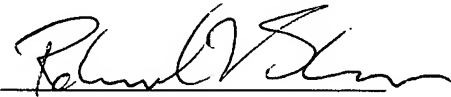
If for any reason the Examiner is unable to allow the application in the next Office Action and feels that an interview will be helpful to resolve any remaining issue, the Examiner is

Amendment under 37 C.F.R. 1.111
U.S. Application No. 10/644,915

Attorney Docket No. Q77116

respectfully requested to contact the undersigned Attorney for the purpose of arranging such an interview.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert V. Sloan", written over a horizontal line.

Robert V. Sloan
Registration No. 22,775

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: March 20, 2006